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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/088,994 | 06/27/2002 | Henri Samain | 13833.0011 | 8997 |
| 7590 | 05/20/2004 | | EXAMINER | |
| D Douglas Price Steptoe & Johnson 1330 Connecticut Avenue N W Washington, DC 20036 | | | VENKAT, JYOTHSNA A | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1615 | |

DATE MAILED: 05/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) |
|------------------------------|-----------------|---------------|
| | 10/088,994 | SAMAIN ET AL. |
| Examiner | Art Unit | |
| JYOTHSNA A VENKAT | 1615 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 February 2004.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 11-15 and 18-24 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 11-15 and 18-24 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.

 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) All b) Some * c) None of:
1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. _____.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: ____.

DETAILED ACTION

Receipt is acknowledged of amendment A filed on 2/29/04. Claims 16-17 have been cancelled and claims 23-24 have been added as per applicant's amendment dated 2/29/04. Claims 11-15 and 18-24 are pending in the application and the status of the application is as follows:

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 11-12, 14, and 18-22 are rejected under 35 U.S.C. 102(b) as being anticipated by U. S. Patent 5, 750,092 ('092).

3. See col.3, lines 10-60 for the silicone compound which reads on “ the organo silicon compound being silane” see the same column for the range which reads on the claimed concentration and the range of claim 12, the compound also reads on claim 13 wherein the basic chemical function is both primary and secondary amine as the silicone compound has NH and NH₂ moieties in the same molecule. See example 1, for HCL, which reads on the claimed neutralizing agent, which is acid. The example 7 reads on the neutralizing agent, which is organic acid. The claims are drawn to cosmetic compositions, which reads on the compositions of the patent. Claims 20-21 are also anticipated in view of intended use.

Response to Arguments

4. Applicant's arguments filed 2/29/04 have been fully considered but they are not persuasive.
5. Applicants argue that the patent '092 does not describe compositions containing an organosilicon compound with one silicon atom as defined in claim 11 or any composition containing an organosilicon compound with two or three silicon atoms in claim 1. Applicants also argue that the compound of the patent has secondary amine whereas the organosilicon compounds of the present invention contain an amino group and therefore the patent does not anticipate the claims.
6. In response to the above argument, it is the position of the examiner that the claims rejected does not have the limitation of claim m13 or the structure of claim 15. Note that the claims recite very broadly" an organosilicon compound being a silane having one silicon atom, the organo silicone compound also having at least one basis functional group and at least two hydrolysable or hydroxy groups per molecule. The patent discloses formula, which has silicon atom, and it has nitrogen atom, which is basic functional group, and the silicon atom is substituted with hydroxyl groups. Therefore the 102 rejection is deemed proper.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground

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provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 11-15, and 18-24 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/069,220. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant application and the claims in the co-pending application are claiming cosmetic composition comprising in a cosmetically acceptable medium un polymerized organosilicon compound, the composition containing sufficient amount of neutralizing agent. the difference is in the co-pending application the concentration of the organosilicon compound is at least 0.05% where as in the instant application is it at least 0.02%. Optimizing the organo silicon compound is obvious to one of ordinary skill inn the art so that the compositions are also effective in holding the hair or shaping the hair.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JYOTHSNA A VENKAT whose telephone number is 571-272-0607. The examiner can normally be reached on Monday-Thursday, 9:30-7:30:1st and 2nd Friday off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, THURMAN K PAGE can be reached on 571-272-0602. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


JYOTHSNA A VENKAT
Primary Examiner
Art Unit 1615
